

REMARKS/ARGUMENTS

The present Amendment and Response comprises Applicant's reply to the Examiner's October 29, 2009 Non-Final Office Action. Claims 2, 10, and 21-25 were previously cancelled and Claims 3-9, 11, 16-20, 27 and 29 are currently cancelled. Claims 1, 12, 26 and 28 are currently amended. Accordingly, Claims 1, 12-15, 26, 28 and 30-35 are now pending in view of the above amendments.

Applicant believes that no new matter has been added with regard to the claim amendments provided herein. Applicant does not donate or disclaim any claims or subject matter with the claim amendments made herein, and the Applicant expressly reserves the right to prosecute the original claims or any unclaimed subject matter in one or more future filed continuing applications.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, the Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding. Also, Applicant's arguments related to each cited reference are not an admission that the cited references are, in fact, prior art.

I. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. § 102(b)

The Examiner rejected Claims 1, 3-9, 11-20, 26-29, 34, and 35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,203,543 to Glossop (“Glossop”). It is well recognized that claims are anticipated if, and only if, each and every element, as set forth in the claim is found in a single prior art reference. Vertegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown as a complete detail as contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). See MPEP § 2131. To constitute anticipation, all material elements of the claim must be found in one prior art source. In re Marshall, 198 U.S.P.Q. 344 (C.C.P.A. 1978). Additionally, the elements of the reference must be arranged as required by the claim. In re Bond, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1999). Applicant respectfully submits that the cited reference does not teach all the materials elements and do not arrange the elements as required by the rejected claim language.

Applicant asserts that Glossop does not teach the limitations (as indicated by italics below) of currently amended Claims 1, 12, 26 and 28. Support for such amendments can be found in the application drawings, including Figs. 1-12.

1. A surgical aid assembly for attachment to a bone of a patient, the patient further having a tissue, the surgical aid assembly comprising:
 - a securing mechanism, wherein said securing mechanism consists of only one bone screw;
 - a body having *a first surface longer than a second surface, wherein the first surface is parallel to a longitudinal axis of the body, and the body having a first aperture on the first surface and a second aperture on the second surface both sized to receive said securing mechanism, wherein an axis is disposed along a passageway between the first aperture and the second aperture, further wherein the axis of the passageway obliquely traverses the longitudinal axis of the body, and wherein the securing mechanism is inserted through the first aperture and the*

second aperture and inserted into the patient's bone for temporarily stabilizing the image tracker to the patient's bone;

an attachment point disposed on the body for attaching an image tracker to the body;

at least one stabilizing projection to seat the body to the patient's bone or tissue, wherein the at least one stabilizing projection is positioned on the second surface of the body; and

an inner flange within the passageway between the first aperture and the second aperture.

12. A surgical aid assembly for attachment to a patient's bone, comprising:

an image tracker;

a mounting base for stabilizing the image tracker, the mounting base including a body having *a longitudinal axis*, and having an entrance aperture and an exit aperture and a passageway therebetween; *wherein the passageway has a central axis that obliquely traverse the longitudinal axis of the mounting base;*

means for securing the base to the patient's bone, wherein said means for securing is sized to be received in said passageway, wherein the means for securing is inserted through the entrance aperture, the passageway, and the exit aperture and inserted into the patient's bone for temporarily stabilizing the image tracker

means for stabilizing the body from rotating; and

means for attaching the image tracker to the body; and
an inner flange within the passageway.

26. A surgical aid assembly for attachment to a patient's bone, comprising:

an image tracker;

a device for stabilizing the image tracker to the patient's bone, the device including a body comprising:

a plurality of surfaces comprising:

a top surface;

a bottom surface;

a first side surface; and

a second side surface, *wherein the first side surface and second side surface are longer than the top surface and bottom surface and wherein a longitudinal axis is parallel with the first side surface;*

a first aperture disposed on said top surface;

a second aperture disposed on at least one of the surfaces selected from the group consisting of:

said first side surface; and

said second side surface;

a passageway between said first and second apertures, the passageway having an inner flange, *an axis and a set screw operable with the passageway to secure said bone screw in place within the passageway, wherein*

the axis of the passageway obliquely traverses the longitudinal axis of the body and

a projection disposed on at least one of the surfaces selected from the group consisting of:

said second side surface of said body; and

said bottom surface of said body;

a mounting post disposed on said body and operable to releaseably attach the image tracker to said body; and

a securing mechanism consisting of a single bone screw;

wherein said first and second apertures are both sized to receive said bone screw; and

wherein said bone screw is adapted to be inserted through said passageway and into the patient's bone for temporarily stabilizing the image tracker.

28. A surgical aid assembly for attachment to a patient's bone, comprising:

an image tracker;

a device for stabilizing the image tracker to the patient's bone, the device including a body comprising:

a plurality of surfaces comprising:

a top surface;

a bottom surface;

a first side surface; and

a second side surface wherein the first side surface and second side surface are longer than the top surface and bottom surface and wherein a longitudinal axis is parallel with the first side surface;

a first aperture disposed on said first side surface;

a second aperture disposed on at least one of the surfaces selected from the group consisting of:

said bottom surface; and

said second side surface;

a passageway between said first and second apertures, the passageway having an inner flange, *an axis and a set screw operable with the passageway to secure said bone screw in place within the passageway, wherein the axis of the passage obliquely traverses the longitudinal axis of the body;* and

a projection disposed on at least one of the surfaces selected from the group consisting of:

said second side surface of said body; and

said bottom surface of said body;

a mounting post disposed on said body and operable to releaseably attach the image tracker to said body; and

a securing mechanism consisting of a single bone screw;

wherein said first and second apertures are both sized to receive said bone screw; and

wherein said bone screw is adapted to be inserted through said passageway and into the patient's bone for temporarily stabilizing the image tracker.

Since Glossop does not teach the device and method as disclosed in this application, Applicant respectfully requests that the rejection of Claims 1, 12, 26 and 28 under 35 U.S.C. § 102(b) be withdrawn. Claims 3-11 and 16-20 have been cancelled. As such, the rejection of Claims 3-11 and 16-20 under 35 U.S.C. § 102(b) is moot. Claims 13-15, 34, and 35 are dependent claims of now allowable independent Claims 1, 12 and 26. Accordingly, Applicant respectfully request that the rejection under 35 U.S.C. § 102(b) of Claims 13-15, 34 and 35 also be withdrawn.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejected Claims 30-33 under 35 U.S.C. § 103 as being unpatentable over Glossop. The U.S. Supreme Court, in KSR Int'l. Co. v. Teleflex Inc., 82 USPQ 2d 1385, 1391 (2007), reiterated the standard for determining obviousness under 35 U.S.C. § 103 as being the factual inquiries set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966). In Graham, the Court stated that obviousness is determined by first determining the scope and content of the prior art, then ascertaining the differences between the invention, as claimed, and the prior art, and then resolving the level of ordinary skill in the prior art. Against this background, the obviousness or non-obviousness of the claimed subject matter is determined. Secondary considerations may also be utilized in this analysis to give light to the circumstances surrounding the origin of the subject matter sought to be patented. KSR Int'l Co., 82 USPQ 2d at 1391. When making any obviousness rejection, the Examiner must first acquire a thorough understanding of the claimed invention by reading the specification and claims to understand what the Applicant is claiming as his invention. MPEP § 904.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the Examiner must clearly articulate the reason(s) why the claimed invention would have been obvious (i.e., the analysis supporting the rejection must be made explicit.) See MPEP § 2142. “Rejections on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See MPEP § 2142; In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); see also KSR Int’l Co., 82 USPQ 2d at 1396. To support a 103(a) rejection, the examiner must demonstrate that a person of ordinary skill in the art would have had reason to attempt to make the claimed device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so. See Noelle v. Lederman, 355 F.3d 1343, 1351–52 (Fed. Cir. 2004); Brown & Williamson Tobacco Co. v. Philip Morris, Inc., 229 F.3d 1120, 1121 (Fed. Cir. 2000); see also KSR Int’l Co., 82 USPQ2d at 1391.

Applicant traverses the Examiner’s rejection for obviousness on the grounds that Glossop does not teach the limitations of amended Claims 1, 12, 26, and 28. In addition, the Examiner has cited that Nerwin v. Erlichman stands for the legal holding “that constructing a formerly integral structure in various elements involves only routine skill in the art.” Assuming, *arguendo*, that this is what was “held” in Nerwin v. Erlichman as asserted by the Examiner, this still does not address the limitation that the “pin...is removably attachable to the body,” as claimed in rejected Claims 30-33. That is, whether or not something can be made of several elements does not address that the pin is removably attachable to the body, as claimed by the Applicant. Accordingly, Applicant submits that the Examiner has failed to set forth a *prima facie* case for obviousness and respectfully request that the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicant believes the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Applicant believes no fees are due for this submission. However, please credit any over payment or debit any under payment to Deposit Account No. 08-2665.

Respectfully submitted,

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